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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/783,207	02/20/2004	Jim B. Surjaatmadja	2003-IP-012367U1	6688

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Robert A. Kent
Halliburton Energy Services
2600 South 2nd Street
Duncan, OK 73536-0440

EXAMINER

CARRILLO, BIBI SHARIDAN

ART UNIT	PAPER NUMBER
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1746

DATE MAILED: 07/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

AS

Office Action Summary	Application No. 10/783,207	Applicant(s) SURJAATMADJA ET AL.	
	Examiner Sharidan Carrillo	Art Unit 1746	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 February 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-59 is/are pending in the application.
- 4a) Of the above claim(s) 19-59 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-59 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>05102004, 06302004</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-18, drawn to a method of cleaning a surface, classified in class 134, subclass 6.
 - II. Claims 19-59, drawn to a method of cutting a surface, classified in class 166, subclass 297+.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I and II are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions have different functions.

3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

4. During a telephone conversation with Mr. Robert Kent on 6/28/04 a provisional election was made without traverse to prosecute the invention of Group I, claims 1-18.

Affirmation of this election must be made by applicant in replying to this Office action.

Claims 19-59 are withdrawn from further consideration by the examiner, 37

CFR 1.142(b), as being drawn to a non-elected invention.

5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one

or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Claim Rejections - 35 USC § 112

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. Claims 1-18 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for the base fluid being fresh water, salt water, brine, seawater, mineral oil, synthetic oil, or an ester, does not reasonably provide enablement for the base fluid being any liquid or any gas. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention commensurate in scope with these claims.

The claims embrace an invention which contains any known fluid, the fluid by definition can be a liquid or a gas, which could/can be selected from literally thousands. It does not appear to be feasible that any liquid or any gas would function in the present invention. Further, for one skilled in the art to reproduce the present invention (which must be possible, if the specification is adequate), there would clearly be undue experimentations to do so in an attempt to figure out which liquids and gases would work and which ones would not. Therefore claim 1 should be amended to recite, in a Markush group, the limitations of claims 3 and 9.

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claims 1-18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 is indefinite because it is unclear what is meant by base fluid. Claim 5 recites polyethylene oxide twice. Claim 10 is indefinite because the cleaning fluid lacks positive antecedent basis.

Claim Rejections - 35 USC § 102

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

11. Claims 1-3, 6-7 and 17 are rejected under 35 U.S.C. 102(b) as being anticipated by Scapanski (6028113).

In reference to claims 1-3, Scapanski teaches a method of cleaning a hard surface by spraying a cleaning composition. Scapanski teaches dissolving a solid sanitizing composition with fresh water and spraying onto a surface (Abstract, Fig. 1, col. 4, lines 55-60, col. 7, lines 20-25, col. 10, lines 30-50, Example 9, col. 9, lines 5-10). In reference to claims 6-7, refer to col. 10, lines 5-15. In reference to claim 17, refer to col. 7, lines 30-31.

12. Claims 1-6, 8-13, and 17 are rejected under 35 U.S.C. 102(b) as being anticipated by Houghton et al. (EP0510762A2).

Houghton et al. teach a non-aqueous liquid cleaning composition comprising a particulate solid phase for cleaning hard surfaces or warewashing (Abstract, p. 4). The limitations of jetting would inherently be met since Houghton teaches using the composition for warewashing by mechanical means and automatic dishwashing machines perform jetting of the cleaning composition on the surface of the dishware. In reference to claims 2-3, refer to page 9. In reference to claims 4-5, refer to page 2. In reference to claim 6, refer to page 9, lines 30-32. In reference to claims 8-9, refer to page 4, lines 5-10. In reference to claims 10-13, refer to page 8, lines 25-28. In reference to claim 17, refer to page 8, lines 53-54.

13. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

14. Claims 1, 8, and 15-16 are rejected under 35 U.S.C. 102(e) as being anticipated by Banerjee et al. (US2003/0188766A1).

Banerjee et al. teach cleaning a wafer surface by simultaneously jetting liquid in combination with carbon dioxide particles unto a surface (Fig. 1, paragraphs 17, 21, and 24). In reference to claim 8, refer to paragraph 17. In reference to claim 15, refer to paragraph 21. In reference to claim 16, refer to col. 3, lines 1-5.

Claim Rejections - 35 USC § 103

15. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

16. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

17. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

18. Claims 1-5, 14, and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over MacVitte et al. (3272650).

In reference to claims 1-2, MacVitte et al. teach a method of cleaning an interior

surface of a conduit by contacting with a liquid suspension comprising polymer particles (i.e. polycarbonate, col. 1, lines 35-42, col. 2, lines 7-13). In reference to claim 1, MacVitte et al. fail to teach jetting. However, applying fluid to a surface by spraying or jetting is conventionally and notoriously well known in the art as evidenced by Scapanski, or Banerjee et al., as previously discussed above. In reference to claims 2-3, MacVitte et al. teach using water. In reference to claim 14, refer to col. 3, lines 20-25. In reference to claim 18, refer to col. 1, lines 35-40.

19. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Bishop et al. teach carbon dioxide cleaning. Binder teaches a detergent tablet. Scapanski teaches a hydrated salt cleaning agent. Yamaguchi teaches cleaning a building with PVA polymers. Hattenbrun teaches PVA particles. Cockrell teaches rubber pellets. Yam teaches water soluble blast media.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sharidan Carrillo whose telephone number is 571-272-1297. The examiner can normally be reached on Monday-Friday, 6:00a.m-2:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Barr can be reached on 571-272-1414. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Sharidan Carrillo
Primary Examiner
Art Unit 1746

bsc



SHARIDAN CARRILLO
PRIMARY EXAMINER